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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,379	09/18/2000	Yuriyo Asami	862.C2010	4732

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EXAMINER

GHEE, ASHANTI

ART UNIT PAPER NUMBER

2626

DATE MAILED: 06/18/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,379

Applicant(s)

ASAMI, YURIYO

Examiner

Ashanti Ghee

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 13-25, 30-36, 38-40 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-12, 26-29 and 37, 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II, claim 9-12, 26-29, 37, and 41 in the reply filed on 6/2/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 9 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshioka (US Patent No. 5,713,061).

Regarding claims 9 and 26, Yoshioka discloses an information processing method of printing a cover image and body images on both sides of a plurality of sheets, comprising: a step of determining (determining, col. 12, lines 22-32) one of a first mode (col. 9, lines 20-39) for allowing (for copying) the cover image (front cover sheet) and the body image (copying on the back side of the front cover sheet reads on the body image to be printed on different sides of the same sheet) to be printed on different sides of the same sheet (col. 9, lines 20-39) and a second mode (FRONT:COPY, BACK, NON-COPY) for inhibiting (copy is to be made only on the front side) the cover image

(front cover sheet) and the body image (mode for copying on the back side of the front cover sheet, col. 9, lines 30-38) to be printed on different sides of the same sheet (col. 9, lines 30-38 and col. 11, lines 11-14); and a generation step (inter-sheet mode reads on generating step) of generating (inputting in the context of this reference reads on generating) an image (image, col. 12, lines 50-52) to be inserted (inputting) between the cover image and the body image (inter-sheet is inserted in a desired portion, col. 8, lines 18-24) when the second mode (FRONT:COPY, BACK, NON-COPY) is determined (col. 10, lines 2-44).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-12 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka (US Patent No. 5,713,061) in view of Abe (US Patent No. 6,678,069 B1).

Regarding claims 10 and 27, Yoshioka does not specifically disclose a generation step of generating the body image by laying out an original image as the basis for a template.

However, Abe discloses the method further comprising a generation step of generating the body image by laying out an original image as the basis for a template (col. 15, lines 29-36).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Yoshioka and Abe due to both references disclosing image forming apparatus that outputs image data to improve operation efficiency.

Regarding claims 11 and 28, Yoshioka does not specifically disclose the template contains a background image.

However, Abe discloses the method wherein the template contains a background image (Fig. 21, the form image has different shapes on it and therefore is representing a background image).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Yoshioka and Abe due to both references disclosing image forming apparatus that outputs image data to improve operation efficiency.

Regarding claims 12 and 29, Yoshioka discloses the generation step of generating the body image (col. 10, lines 2-44).

Although Yoshioka does not disclose using a background image, Abe discloses the method by laying out an original image comprises a step of using a background image in the template (Fig. 21, the form image is incorporate with the original image and is therefore used as a background and a template).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Yoshioka and Abe due to both references disclosing image forming apparatus that outputs image data to improve operation efficiency.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 37 and 41 rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Knodt et al. (US Patent No. 5,124,731) discloses generation of document covers in and electronic reprographic system using memory.

Kassman (US Patent No. 5,642,205) discloses a method and system for printing a simplex fax cover when in a duplex fax printing mode.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashanti Ghee whose telephone number is (703) 306-3443. The examiner can normally be reached on Mon-Thurs and alt. Fri. (7-4PM).

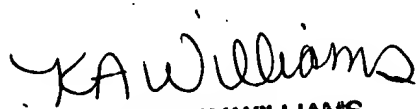
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AG
June 14, 2004

Ashanti Ghee
Examiner
Art Unit 2626



KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER